



UNITED STATES DEPARTMENT OF COMMERCE
Pat nt and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/029,408 10/01/98 BAAR

A GEY-1020

IM22/1208

GERALD H KIEL
MCAULAY FISHER NISSEN GOLDBERG & KIEL
261 MADISON AVENUE
NEW YORK NY 10016-2391

EXAMINER

NOLAN, S

ART UNIT

PAPER NUMBER

1772

DATE MAILED:

12/08/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/029,408

Applicant(s)
BAAR Et A;

Examiner
Sandra Nolan

Group Art Unit
1772



☒ Responsive to communication(s) filed on Sept. 29, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 60-70 is/are pending in the applicat

Of the above, claim(s) 65-70 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 60-64 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1772

DETAILED ACTION

Election/Restriction

1. Newly submitted claims 65-70 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the process defined in claim 65 produces a molded article that does not have multiple layers, while the originally presented claims covered multilayered articles.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 65-70 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Rejections Withdrawn

2. The 35 USC 112 rejection of claims 1, 7, 11, 17, 38, 39, 46, 48, 52, 54, and 58, as set forth in paragraph 4 of the Office Action dated March 16, 2000 (Paper No. 9), is withdrawn in view of Applicants' amendments in the response of September 29, 2000 (Paper No. 13)

3. The 35 USC 103 rejection of claims 1, 5, 7, 11-21, 23-48 and 53 as unpatentable over Mayer et al (US 5,288,318) in view of Pommier et al (US 5,039,378) or Arnold et al (WO 95/20628), as recited in paragraph 5 of Paper No. 9, is withdrawn in view of Applicants' amendments in Paper No. 13.

4. The 35 USC 103 rejection of claims 1-4, 7-9, 22, and 48-53 as being unpatentable over Kharas et al (CA 2057669A) or Suskind (US 5,540,962) in view of Pommier et al or Arnold et al,

Art Unit: 1772

as recited in paragraph 6 of Paper No. 9, is withdrawn in view of Applicants' amendments in Paper No. 13.

5. The 35 USC 103 rejection of claims 2-4, 6, 8-10, 22 and 48-59 as unpatentable over Kharas et al, Suskind, Pommier et al and Arnold et al, as applied to claims 1-4, 7-9, 22, and 48-53 above, and further in view of Tanner et al (US 5,213,858), as explained in paragraph 7 of Paper No. 9, is withdrawn in view of Applicants' amendments in Paper No. 13.

New Rejections

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "completed" appears to be a misspelling of "completely". Please clarify/correct.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1772

9. Claims 60-62 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pommier et al (US 5,039,378) in view of Haas et al (US 5,576,049).

Pommier et al show the production of a packing paper by binding long and short fibers (col. 2, lines 26+) and talc (col. 2, line 57) with starch (col. 3, line 3) and pressing (col. 5, line 36). They do not show the application of a coating to the pressed product.

Haas et al teach the use of cellulose acetate coatings (col. 11, line 62 and claim 2 of the patent) on shaped articles as water-repellent coatings. They teach that their coatings must be hydrophobic, elastic and cohesive (col. 11, lines 20-52). The coatings are applied to preformed substrates (col. 11, lines 37-42).

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the water-repellent coatings of Haas et al to coat the pressed paper products of Pommier et al in order to make them suitable for containing moist foods.

The motivation to employ the cellulosic coatings of Haas et al is found at col. 11 of that patent, where the physical properties of the coatings are discussed.

10. Claims 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pommier et al in view of Kharas et al (abstract of CA 2057669).

Pommier et al is discussed above.

Kharas et al disclose the use polylactide coatings for fibrous webs to yield biodegradable products. See the entire abstract, especially the last sentence.

Art Unit: 1772

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the polylactide coatings of Kharas et al to enhance the biodegradability of the products of Pommier et al.

The motivation to employ the coatings of Kharas et al on the products of Pommier et al is found in the last sentence of the abstract, where the biodegradability of the product is mentioned.

11. Claims 60-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiefenbacher et al (US 5,376,320) in view of Haas et al.

Tiefenbacher et al show the preparation of "rotable" shaped bodies by baking a starch-containing mix in a mold and subsequently conditioning (col. 1, lines 6-11). The bodies contain fibers of 0.03-1.5 mm length (col. 9, lines 11+), and talc or kaolin (col. 9, line 34). They may have plastic layers (col. 21, line 13). They do not teach the coating of preformed substrates.

Haas et al is discussed above.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the cellulose acetate coatings of Haas et al as plastic coatings for the shaped bodies of Tiefenbacher et al and to apply them via a separate coating step, as taught by Haas et al.

The suggestion to employ the coating operation and cellulose acetate coating of Haas et al in the process of Tiefenbacher et al is found in col. 11 of Haas et al, where the advantages of hydrophobic coatings and a separate coating step, e.g., for filling cracks and pores, are discussed.

12. Claims 60-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tiefenbacher et al in view of Kharas et al.

Art Unit: 1772

Tiefenbacher et al is discussed above. They do not show polylactide coatings.

Kharas et al is discussed above.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the polylactide coatings of Kharas et al on the shaped articles of Tiefenbacher et al in order to enhance the biodegradability of the products.

The motivation to employ the coatings of Kharas et al to enhance biodegradability is found in the last sentence of the Kharas et al abstract, where biodegradability is discussed.

Response to Arguments


13. Applicant's arguments with respect to claims 60-64 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra M. Nolan, whose telephone number is (703) 308-9545. The examiner can normally be reached on Monday through Thursday from 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ellis P. Robinson, can be reached on (703) 308-2364. The fax phone number for the art unit is (703) 305-5408. The telephone number for the receptionist is (703) 308-0661.

SMN/smn
December 6, 2000
09029408.2


Ellis Robinson
Supervisory Patent Examiner
Technology Center 1700